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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/113,071	07/10/98	SILVERBROOK	K ART32US

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EXAMINER

KIM.P

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 06/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/113,071

Applicant(s)

Silverbrook et al.

Examiner

PETER KIM

Group Art Unit
2851



☒ Responsive to communication(s) filed on May 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

Abstract should be a single paragraph and terms such as "said" should not be used.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg et al. (Steinberg) in view of Stephenson.

Steinberg discloses in Figure 1 and column 1, line 58 through column 4, line 62, a portable camera (ref. 10) for capturing a digital image and an integral programming language interpreter means for manipulation of the digital image and a script input means (ref. 18) for inputting a programming script on a card (ref. 22) wherein the script is executed to modify the image. However, Steinberg does not disclose a digital camera with an integral printer. Stephenson discloses in Figure 3, a digital camera with an integral printer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an

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integral printer to the digital camera of Steinberg in view of Stephenson in order to instantly print the captured and modified digital image.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murase et al. (Murase) in view of Stephenson.

Murase discloses in Figures 1A-1C and column 3, line 50 through column 4, line 45, a portable camera (ref. 1) for capturing a digital image and an integral programming language interpreter means for manipulation of the digital image and a script input means (ref. 8) for inputting a programming script on a card (ref. 9) wherein the script is executed to modify the image. Murase also disclose that the disc with the programming language is similar to musical or audio minidisk which does have encoded information on one side and picture or description on the other side. However, Murase does not disclose a digital camera with an integral printer. Stephenson discloses in Figure 3, a digital camera with an integral printer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an integral printer to the digital camera of Murase in view of Stephenson in order to instantly print the captured and modified digital image.

5. Claims 1, 2 and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg et al. (Steinberg) in view of Finelli et al. (Finelli).

Steinberg discloses in Figure 1 and column 1, line 58 through column 4, line 62, a portable camera (ref. 10) for capturing a digital image and an integral programming language interpreter means for manipulation of the digital image and a script input means (ref. 18) for inputting a

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programming script on a card (ref. 22) wherein the script is executed to modify the image.

However, Steinberg does not disclose a digital camera with an integral printer. Finelli discloses a digital camera with a detachable printer which is made integral to the camera. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an integral printer to the digital camera of Steinberg in view of Finelli in order to instantly print the captured and modified digital image.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murase et al. (Murase) in view of Finelli et al. (Finelli).

Murase discloses in Figures 1A-1C and column 3, line 50 through column 4, line 45, a portable camera (ref. 1) for capturing a digital image and an integral programming language interpreter means for manipulation of the digital image and a script input means (ref. 8) for inputting a programming script on a card (ref. 9) wherein the script is executed to modify the image. Murase also discloses that the disc with the programming language is similar to musical or audio minidisk which does have encoded information on one side and picture or description on the other side. However, Murase does not disclose a digital camera with an integral printer. Finelli discloses a digital camera with a detachable printer which is made integral to the camera. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an integral printer to the digital camera of Murase in view of Finelli in order to instantly print the captured and modified digital image.

Remarks

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7. Applicant argues that amending Claim 1 to input a "self documenting" program script would overcome the rejection. However, the term, "self documenting" includes not only printing the image with the printer integral to the camera, but storing the image in the memory or a disc to "self document" the image. Applicant also argues that Steinberg et al. and Murase et al. do not disclose integral printer with the camera. However, Stephenson discloses a digital camera with an integral printer. Finelli et al. also discloses a camera with a detachable printer that can be made integral to the camera. Since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routing skill in the art, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the inventions of Steinberg et al. and Murase et al. with the integral printer in view of Finelli et al. or Stephenson.

Conclusion

8. All claims are rejected.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Kim whose telephone number is (703) 305-0105. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

PBK

PBK

6/20/00

Russell Adams
Russell Adams
Primary Examiner